

REMARKS

This communication is responsive to the Office Action mailed January 20, 2009 finally rejecting all claims pending in the application ("Final Action"). Claims 1, 3-11 and 15-17 remain pending in the application, of which claims 1 and 8 are presented in independent form. Claims 1, 4-6 and 8 have been amended solely to improve their form in view of the Examiner's formal objections as discussed further below. None of the amendments is intended to narrow the scope of any of these claims, and no new matter has been added by these amendments. Thus, entry of the amendment is respectfully requested.

In the Final Action, the Examiner has objected that the term "a digital copy" as recited in claims 1 and 8 is not found in the specification and therefore its meaning cannot be ascertained. In response, applicant respectfully submits that the specification complies with the requirements set forth in 37 C.F.R. 1.75(d)(1) and fully supports and enables one of ordinary skill to ascertain the meaning of the term "a digital copy" as recited in the claims.

In response, applicant initially notes that while the Examiner has objected to the term "a digital copy", in context independent claims 1 and 8 recite "a framework comprising a digital copy of a physical form". In this regard, paragraph 0028 of the specification discloses:

"The specific blank preferably is a physical blank, also referred to as form, is scanned in a conventional manner by means of a scanner. The electronic file created by the scanning process is referred to as a framework. The framework forms a part of an HTML document."

Thus, paragraph 0028 fully supports and enables one of ordinary skill to ascertain that "a digital copy" means an

electronic file created by scanning a physical form. Indeed, the Examiner himself acknowledges on page 3 of the Final Action that the term "a digital copy" could mean a scanned image, but in raising the objection, appears to have searched for the term in the specification without its surrounding context. In view of the foregoing, applicant submits that the description in paragraph 0028 of the specification supports and enables one of ordinary skill to ascertain the meaning of the term "a digital copy" as it is recited in the claims, and the Examiner is respectfully requested to withdraw the objection.

In addition, the Examiner identified and objected to certain informalities with respect to the language recited in claims 1, 4, and 8. In view of the above amendments, applicant respectfully submits that the formal objections are now fully overcome and should be withdrawn. Furthermore, while not specifically objected to, applicant has also amended claims 5-6 by removing dashes in order to improve their form.

In the Final Action, all of the previously pending claims were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 7,451,392 to Chalecki et. al. ("*Chalecki*") in view of US Patent No. 7,299,408 to Daconta et.al. ("*Daconta*") and further in view of US Patent Pub. No. 2005/1006044 to Patterson ("*Patterson*"). Reconsideration is respectfully requested.

With respect to claim 1, the Examiner acknowledges that both *Chalecki* and *Daconta* fail to teach "a first information entity" that includes a framework comprising a digital copy of a physical form. (Office Action at pg. 7.) Additionally, the Examiner acknowledges that *Chalecki* and *Daconta* fail to also teach "a second information entity" that includes an overlay having

predefined form fields corresponding to the structure of the framework as recited in the claim. *Id.* However, the Examiner asserts that *Patterson* teaches a first information entity and a second information entity as recited in the claims and overcomes the deficiencies in *Chalecki* and *Daconta*. *Id.* Applicant respectfully submits that *Patterson* fails to overcome the deficiencies in *Chalecki* and *Daconta* for the following reasons.

Patterson is generally directed to a system for converting hand written information that a user has entered into an electronic form into a computer recognizable format. (Abstract; ¶2) In this regard, *Patterson* teaches an electronic form that may be filled out by hand by the user using a digital input device such as a digital pen, and ways in which such electronic form may be designed. (See, e.g., ¶¶8-9; See also, ¶29-32.) In this regard, *Patterson* discloses that a user-fillable electronic form may be designed using custom templates and overlays before the form is presented to the user. (¶¶33-34.)

However, even assuming that *Patterson* arguably teaches "a first information entity" that includes a framework that is created using a custom template and an overlay, *Patterson* does not disclose "a second information entity" that includes an overlay where a user provides user-generated information to the second information entity. In this regard, *Patterson* does not teach an overlay that is filled out by the user at all. Rather, *Patterson* at most teaches an electronic form where an already pre-filled overlay populated with static data is incorporated into the form before the user is even presented with the document. (¶¶33-34.) In *Patterson's* own words, "The digital form also includes overlay data

508, which was pulled from one or more data sources and merged with the template. For example, the control code, list and quantity of drugs received, and a host of other information is preprinted onto the digital form." (¶60; FIGURES 11A-11B) In view of the foregoing, applicant respectfully submits that *Patterson* fails to teach a first information entity and a second information entity as recited in claim 1 and therefore does not overcome the deficiencies in *Chalecki* and *Daconta*.

In addition, applicant notes that in the Final Action the Examiner asserts that *Daconta* discloses "a third information entity" that comprises information from "the first information entity" and "the second information entity". (Office Action at pg. 6.) Applicant respectfully disagrees. Based on the Examiner's own admission that *Daconta* (and *Chalecki*) fail to teach "a first information entity" and "a second information entity" as recited in the claims, applicant respectfully submits that it is improper for the Examiner to assert that *Daconta* somehow still teaches "a third information entity" that combines data from the first two entities.

For at least the foregoing reasons, applicant respectfully requests that the Examiner withdraw the rejections to claim 1. As claims 3-7 depend from claim 1, applicant also requests that, for at least the aforementioned reasons, the Examiner withdraw the rejections to these claims as well.

Claim 8 recites language similar or identical to that discussed in detail above with reference to claim 1, and for at least the aforementioned reasons, applicant requests that the Examiner withdraw the rejections to claim 8. As claims 9-11 and 15-17 depend from claim 8, applicant also requests that, for at

least the aforementioned reasons, the Examiner withdraw the rejections to these claims as well.

In view of the above, each of the presently pending claims in this application is believed to in a condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 20, 2010

Respectfully submitted,
Electronic signature: /Niraj A.
Desai/
Niraj A. Desai
Registration No.: 64,934
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

11675751.1.DOC